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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
NALEVANKO, CHRISTOPHER R

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	10/692,513	HALE ET AL.
Office Action Summary	Examiner	Art Unit	
	Christopher R Nalevanko	2611	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _24 October 2003_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-19_ is/are pending in the application.

4a) Of the above claim(s) _20 and 21_ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-19_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.   Claim 1-19, drawn to method of displaying content on a readable display in conjunction with a media presentation, classified in class 345, subclass 730.

II.   Claims 20-21, drawn to a portable device that automatically determines a user preference based on location, and automatically predicts the destination location, classified in class 725, subclass 35. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as determining preferences based on a user location. Invention I merely shows displaying contents on a user device. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Margo Maddux on 09/14/2004 a

provisional election was made with traverse to prosecute the invention of Group I, claims

1-19. Affirmation of this election must be made by applicant in replying to this Office

action. Claims 20-21 withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected

invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a

request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

1.   Claims 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. Claim 18 recites the limitation "the film." There is insufficient antecedent

basis for this limitation in the claim. There has been no prior reference to any limitation

of "film."

***The following art rejections are based on the Examiner's best understanding of the art in light

of the above 35 USC 112 2nd paragraph rejection.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1, 4-11, and 14-19 are rejected under 35 U.S.C. 102(e) as being clearly

anticipated by Wall et al (2002/0120939).

        Regarding Claim 1, Wall shows a method for displaying content data on a

readable display in conjunction with a media presentation (page 1 sections 0004-0005).

Wall further shows displaying media presentation data, the data including time prompts

(page 1 section 0004, media program (slide presentation), method for synchronizing first

and second media programs, page 3 section 0033 synchronization, page 4 section 0046

item 510 display of running time, page 7 sections 0077-0078, fig. 10), the data having

sequences correlated to the time prompts (page 7 sections 0077-0078, synchronizing

presentation data with video file corresponding to time), and transmitting to the readable

display the sequence of content data associated with a detected time prompt (page 2

sections 0019-0022, sending presentations to user devices).

        Regarding Claim 4, Wall shows a wired connection (page 2 section 0022).

        Regarding Claim 5, Wall shows the data can be pre-recorded (page 4 section

0046).

        Regarding Claim 6, Wall shows the media data is a live performance (page 4

section 0046).

Regarding Claim 7, Wall shows storing the content in a memory device, both at the user site and server (page 3 section 0026, stored in media server, page 3 section 0031, downloaded into user system).

Regarding Claim 8, Wall shows displaying the time of the presentation (page 4 section 0046, fig. 5a item 510, page 7 section 0078).

Regarding Claim 9, Wall shows a method for presenting content data on at least one user device (page 1 sections 0004-0005). Wall further shows providing content data at a predetermined time and time prompts on the media (page 1 section 0004, media program (slide presentation), method for synchronizing first and second media programs, page 3 section 0033 synchronization, page 4 section 0046 item 510 display of running time, page 7 sections 0077-0078, fig. 10), detecting the time prompts and correlating the time prompts on the media (page 7 sections 0077-0078, synchronizing presentation data with video file corresponding to time), and transmitting to the user device a sequence of content data associated with a detected time prompt (page 2 sections 0019-0022, sending presentations to user devices, page 7 sections 0077-0078, page 8 section 0088, page 9 section 0100, streaming data to user device, flipping slides).

Regarding Claim 10, Wall shows that the device has a readable display (fig. 5a).

Regarding Claim 11, Wall shows an audio output and data that is outputted through speakers (page 2 sections 0020 and 0022).

Regarding Claim 14, Wall shows a method for displaying content data on a readable display (page 1 sections 0004-0005). Wall further shows providing content data to be displayed at a predetermined time and media data having time prompts, the content

correlated with the prompts (page 1 section 0004, media program (slide presentation),

method for synchronizing first and second media programs, page 3 section 0033

synchronization, page 4 section 0046 item 510 display of running time, page 7 sections

0077-0078, fig. 10), detecting the time prompts (page 7 sections 0077-0078,

synchronizing presentation data with video file corresponding to time), and transmitting,

at a given time prompt, to the readable display the sequence of content data associated

with a detected time prompt (page 2 sections 0019-0022, sending presentations to user

devices, page 8 section 0088, page 9 section 0100, streaming data to user device, flipping

slides).

Regarding Claim 15, Wall shows a method for displaying content data on a

readable display (page 1 sections 0004-0005). Wall further shows storing information to

be displayed (page 9 section 0098), displaying media presentation data, the data including

time prompts (page 1 section 0004, media program (slide presentation), method for

synchronizing first and second media programs, page 3 section 0033 synchronization,

page 4 section 0046 item 510 display of running time, page 7 sections 0077-0078, fig.

10), the data having sequences correlated to the time prompts (page 7 sections 0077-

0078, synchronizing presentation data with video file corresponding to time), and at a

given time prompt, transmitting to the readable display the sequence of content data

associated with a detected time prompt (page 2 sections 0019-0022, sending presentations

to user devices, page 7 sections 0077-0078, page 8 section 0088, page 9 section 0100,

streaming data to user device, flipping slides).

Regarding Claim 16, Wall shows a method for interactive communication in

conjunction with a media presentation (page 1 sections 0004-0005). Wall also shows a

content display device having a readable display (page 2 section 0022) and storing the

content data for display (page 3 section 0026, stored in media server, page 3 section

0031, downloaded into user system). Wall further shows displaying media presentation

data, the data including time prompts (page 1 section 0004, media program (slide

presentation), method for synchronizing first and second media programs, page 3 section

0033 synchronization, page 4 section 0046 item 510 display of running time, page 7

sections 0077-0078, fig. 10), the data having sequences correlated to the time prompts

(page 7 sections 0077-0078, synchronizing presentation data with video file

corresponding to time), and transmitting to the readable display the sequence of content

data associated with a detected time prompt (page 2 sections 0019-0022, sending

presentations to user devices). Finally, Wall shows providing inputs on the content

display device to receive information from the viewer (page 4 section 0038, live chat,

sections 0041-0042, ordering options).

Regarding Claim 17, Wall shows an apparatus for streaming digital data to a

portable device, during a media presentation including time prompts (page 2 section

0020, 0022, page 1 section 0004, media program (slide presentation), method for

synchronizing first and second media programs, page 3 section 0033 synchronization,

page 4 section 0046 item 510 display of running time, page 7 sections 0077-0078, fig.

10), the data having sequences correlated to the time prompts (page 7 sections 0077-

0078, synchronizing presentation data with video file corresponding to time). Wall also

shows a memory device storing the data prior to transmission (page 3 sections 0026, media server), a wireless emitter transmitting the data and a wireless receiver on the portable device (page 2 section 0022, devices connected wirelessly), a time prompt detector (page 7 sections 0077-0078, detecting timing data), a data processor associating prompts to digital data according to rules, or synchronization data (page 7 sections 0077-0078, synchronizing presentation data with video according to time and timing data), and a transmitter for transmitting the data with prompts to the wireless receiver (page 2 sections 0019-0022, sending presentations to user devices, page 7 sections 0077-0078, page 8 section 0088, page 9 section 0100, streaming data to user device, flipping slides).

Regarding Claim 18, Wall shows a method for presenting content data correlated to a media presentation on at least one user device (page 1 sections 0004-0005). Wall further shows providing content data at a predetermined time and time prompts on the media (page 1 section 0004, media program (slide presentation), method for synchronizing first and second media programs, page 3 section 0033 synchronization, page 4 section 0046 item 510 display of running time, page 7 sections 0077-0078, fig. 10), presenting film to the user (page 2 section 0023), detecting the time prompts and correlating the time prompts on the media (page 7 sections 0077-0078, synchronizing presentation data with video file corresponding to time), and transmitting to the user device a sequence of content data associated with a detected time prompts and displaying the content (page 2 sections 0019-0022, sending presentations to user devices, page 7 sections 0077-0078, page 8 section 0088, page 9 section 0100, streaming data to user device, flipping slides).

Regarding Claim 19, Wall shows an apparatus for streaming digital data to a portable device, before and during a media presentation including time prompts (page 2 section 0020, 0022, page 1 section 0004, media program (slide presentation), method for synchronizing first and second media programs, page 3 section 0033 synchronization, page 4 section 0046 item 510 display of running time, page 7 sections 0077-0078, fig. 10, page 7 sections 0077-0078, page 8 section 0088, page 9 section 0100, streaming data to user device, flipping slides), the data having sequences correlated to the time prompts (page 7 sections 0077-0078, synchronizing presentation data with video file corresponding to time). Wall also shows a memory device storing the data prior to transmission (page 3 sections 0026, media server), a wireless emitter transmitting the data and a wireless receiver on the portable device (page 2 section 0022, devices connected wirelessly), a distribution data server to send presentation data (page 3 section 0026, media server), a time prompt detector (page 7 sections 0077-0078, detecting timing data), a data processor associating prompts to digital data according to rules, or synchronization data (page 7 sections 0077-0078, synchronizing presentation data with video according to time and timing data), and a transmitter for transmitting the data with prompts to the wireless receiver (page 2 sections 0019-0022, sending presentations to user devices, page 7 sections 0077-0078, page 8 section 0088, page 9 section 0100, streaming data to user device, flipping slides).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 2, 3, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wall et al (2002/0120939).

Regarding Claim 2, Wall shows that transmitting the multimedia data wirelessly

(page 2 section 0022). Wall fails to specifically state sending the data over IR. Official

Notice is given that it is well known and expected in the art to use IR to transmit data to

devices. This provides and inexpensive and reliable way to transmit data wirelessly.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the system of Wall with the ability to send data of IR in

order to use an inexpensive, simplistic way of sending data wirelessly.

Regarding Claim 3, Wall shows that transmitting the multimedia data wirelessly

(page 2 section 0022). Wall fails to specifically state sending the data over RF. Official

Notice is given that it is well known and expected in the art to use RF to transmit data to

devices. This provides and inexpensive and reliable way to transmit data wirelessly.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the system of Wall with the ability to send data of RF in

order to use an inexpensive, simplistic way of sending data wirelessly.

Regarding Claim 12, the limitations of the claim have been discussed with regards

to Claim 2.

Regarding Claim 13, the limitations of the claim have been discussed with regards to Claim 3.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Moore et al U.S. Patent Application Publication No. 2003/0090506 discloses a method and apparatus for controlling the visual presentation of data.

Raju U.S. Patent Application Publication No. 2003/0160813 discloses a method and apparatus for a dynamically-controlled remote presentation system.

Chiu et al U.S. Patent Application Publication No. 2002/0163548 discloses a system and apparatus for notetaking with digital video and ink.

Chen et al U.S. Patent No. 6,249,281 discloses on-demand presentation graphical user interface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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